

REMARKS

The Official Action mailed July 2, 2008, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Filed concurrently herewith is a *Request for Continued Examination*. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant notes with appreciation the consideration of the Information Disclosure Statements filed on August 28, 2003; December 3, 2004; October 17, 2005; December 9, 2005; April 24, 2006; October 31, 2006; and October 22, 2007.

Claims 3, 5, 8, 13, 18, 23, 28, 33, 36-43, 45, 47-57, 74-80 and 82-87 are pending in the present application, of which claims 3, 36, 37, 74 and 82 are independent. The Applicant notes with appreciation the allowance of claims 3, 5, 8, 13, 18, 23, 28, 33 and 74-80 (Box 5, Office Action Summary, page 8, Paper No. 20080627). Claims 36, 37 and 82 have been amended to better recite the features of the present invention. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

The Official Action rejects claims 82-84 as anticipated by U.S. Publication No. 2007/0087492 to Yamanaka. The Applicant respectfully submits that an anticipation rejection cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP § 2131, to establish an anticipation rejection, each and every element as set forth in the claim must be described either expressly or inherently in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Independent claim 82 has been amended to recite wherein an entire top surface of the semiconductor layer is covered by the conductive layer when the semiconductor layer is selectively heated. This amendment is supported by the specification, for example, at page 6, lines 12-13, page 7, lines 7-8, and Figures 1A-1B. For the reasons

provided below, the Applicant respectfully submits that Yamanaka does not teach the above-referenced features of the present invention, either explicitly or inherently.

The Official Action concedes that "the semiconductor layer is partly covered by the conductive layer when the heating process occurs (see paragraph# 471)" (page 3, lines 12-13, page 5, lines 4-5, and page 8, lines 18-20, Paper No. 20080627; emphasis added). Therefore, the Applicant respectfully submits that Yamanaka does not teach an entire top surface of the semiconductor layer is covered by the conductive layer, either explicitly or inherently.

Since Yamanaka does not teach all the elements of the independent claims, either explicitly or inherently, an anticipation rejection cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 102 are in order and respectfully requested.

The Official Action rejects claims 36-41, 42, 43, 45, 47-57 and 85-87 as obvious based on the combination of Yamanaka and U.S. Publication No. 2001/0049163 to Yamazaki. The Applicant respectfully submits that a *prima facie* case of obviousness cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some reason to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the

problem to be solved as a whole would have suggested to those of ordinary skill in the art.” In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The prior art, either alone or in combination, does not teach or suggest all the features of the independent claims, as amended. Independent claim 36 has been amended to recite wherein an entire top surface of the first semiconductor layer and an entire top surface of the second semiconductor layer are covered by the non-transparent layers when the region is locally heated. Independent claim 37 has been amended to recite wherein an entire top surface of the semiconductor layer is covered by the non-transparent layer when the semiconductor layer is selectively heated.

Please incorporate the arguments above with respect to the deficiencies in Yamanaka. Yamazaki does not cure the deficiencies in Yamanaka. The Official Action relies on Yamazaki to allegedly teach “forming a conductive film by using metal or metal nitride, or metal silicide” (page 5, Paper No. 20080627), “heating of the first and second semiconductive layers” (page 7, Id.) and that “the heat treatment is performed at a temperature not less than a distortion point of the substrate” (Id.). However, Yamanaka and Yamazaki, either alone or in combination, do not teach or suggest that Yamanaka should be modified so that an entire top surface of the first semiconductor layer and an entire top surface of the second semiconductor layer are covered by the non-transparent layers when the region is locally heated; or so that an entire top surface of the semiconductor layer is covered by the non-transparent layer when the semiconductor layer is selectively heated. Since Yamanaka and Yamazaki do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Since Yamanaka and Yamazaki do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration

and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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